



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------|------------------|
| 09/990,001 | 11/21/2001 | Futoshi Hachimura | B422-176 | 6301 |
| 26272 | 7590 | 08/04/2005 | EXAMINER CHAI, LONGBIT | |
| COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS 1133 AVE OF THE AMERICAS NEW YORK, NY 10036 | | | ART UNIT 2131 | PAPER NUMBER |

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,001

Applicant(s)

HACHIMURA, FUTOSHI

Examiner

Longbit Chai

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-14 and 16-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

20

DETAILED ACTION

1. Claims 1 – 30 have been presented for examination. Claims 2 and 15 have been canceled; claims 1, 3 – 13, 14 and 16 – 30 have been amended in an amendment filed 6/29/2005.

Response to Arguments

1. Applicant's arguments filed on 6/29/2005 with respect to the subject matter of the instant claims have been fully considered but are not persuasive.

2. As per claim 1, 13, 14 and 26 – 30, Applicant remarks: "Anderson does not teach the client does not have to have a key to decrypt the encrypted message (Page 13, 2nd Para, Last sentence". Examiner notes Applicant's arguments have been fully considered but are not persuasive. Anderson teaches: (a) the specific users (i.e. clients) do not have to have a key because the public /private keys are assigned to systems rather than to specific users (i.e. clients) (Anderson: Para [0022] Line 18 – 19); (b) In addition, Anderson discloses the client could require only a small amount of storage space – without the needs to save and manage the messages – so that the client need only be able to display a message and to send request to the server (i.e. MDS – Message Distribution Server) (Anderson: Para [0021] Line 4 – 9); and (c) the system then manages requests from the client to access the message by permitting access when appropriate, and the system (i.e. server computer system) performs decrypting the message if necessary (Anderson: Para [0006] Line 9 – 12). Therefore,

Art Unit: 2131

Anderson does indeed teach the client does not have to have a key to decrypt the encrypted message;).

3. Furthermore, Applicant argues: "Anderson does not teach any authentication of the allowance of the use of a recipient of a managed key of the processing and does not disclose the message can therefore be decrypted upon such authentication and transmission of the decrypted message to the client". Examiner notes Applicant's arguments have been fully considered but are not persuasive. Anderson teaches: (a) the system retrieves an encryption key for a server (i.e. the "managed key" to meet the claim language) and sends the encrypted message to the server (Anderson: Para [0008] Line 6 – 10); (b) the system then manages requests from the client to access the message by permitting access when appropriate, and the system (i.e. server computer system) performs decrypting the message if necessary (Anderson: Para [0006] Line 9 – 12); and (c) the specific users (i.e. clients) do not have to have a key because the public /private keys are assigned to systems rather than to specific users (i.e. clients) (Anderson: Para [0022] Line 18 – 19). Therefore, Anderson does indeed teach the authentication of the allowance of the use of a recipient of a managed key of the processing and the message can therefore be decrypted upon such authentication and transmission of the decrypted message to the client.

4. As per claim 13, 26, 28 and 30, Applicant remarks: "these claims further recite that the client requesting to decrypt the encrypted message, sending the authentication information and receiving the decrypted message transmitted in said transmission step (Page 12, Last sentence)". Examiner notes Anderson teaches: (a) the system retrieves

Art Unit: 2131

an encryption key for a server (i.e. the “managed key” to meet the claim language) and sends the encrypted message to the server (Anderson: Para [0008] Line 6 – 10), (b) the client could send request to the server when the client requires only a small amount of storage space – without the needs to save and manage the messages – so that the client need only be able to display a message (i.e. MDS – Message Distribution Server) (Anderson: Para [0021] Line 4 – 9), and (c) the system then manages requests from the client to access the message by permitting access when appropriate, and the system (i.e. server computer system) performs decrypting the message if necessary (Anderson: Para [0006] Line 9 – 12). Thereby, Anderson does indeed teach the client requesting to decrypt the encrypted message, sending the authentication information and receiving the decrypted message transmitted in said transmission step.

5. Examiner notes considering several repetitive claim limitations in the claims 1 – 30 and the incorporation of cancelled claims 2 and 15 into existing claims 1 and 14 respectively, please refer to 1st Non-Final Office action along with the “Response to Arguments” set forth in this 2nd Office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2131

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai
Examiner
Art Unit 2131

LBC
LBC

Ayaz Sheikh
AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100